LAW OFFICES OF
FAY KAPLUN & MARCIN, LLP
INTELLECTUAL PROPERTY LAW

150 BROADWAY, SUITE 702
NEW YORK, NEW YORK 10038
PHONE: (212) 619-6000
FAX: (212) 208-6819
WWW.FKMIPLAW.COM

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FAX NO : (571) 273-8300

TO : Commissioner for Patents
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FROM : Oleg F. Kaplun, Esq. of Fay Kaplun & Marcin, LLP

DATE : May 7, 2007

SUBJECT : U.S. Patent Appln. Serial No. 09/900,335
for *Substituting URL for Attachment in Forwarding Electronic Content*
Phillips Ref.: US 018099

NUMBER OF PAGES INCLUDING COVER : 20

MESSAGE:

Please see attached.

Attorney Docket No. US018099

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s)	:	Kaars
Serial No.	:	09/900,335
Filing Date	:	July 5, 2001
For	:	Substituting URL for Attachment in Forwarding Electronic Content
Group Art Unit	:	2153
Examiner	:	Philip J. Chea

Mail Stop: Appeal Brief - Patent
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By: Oleg F. Kaplun, Reg. No. 45,559 Date: May 7, 2007

TRANSMITTAL

In support of the Notice of Appeal filed on March 7, 2007, transmitted herewith please find an Appeal Brief for filing in the above-identified application. Please charge the Credit Card of **Fay Kaplun & Marcin, LLP** in the amount of $500.00 (PTO-Form 2038 is enclosed herewith). The Commissioner is hereby authorized to charge the **Deposit Account of Fay Kaplun & Marcin, LLP NO. 50-1492** for any additional required fees. A copy of this paper is enclosed for that purpose.

Respectfully submitted,

Dated: May 7, 2007

By: _____
Oleg F. Kaplun, Reg. 45,559

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
	)	
Peter Bernhard Kaars	)	
	)	
Serial No.: 09/900,335	)	Group Art Unit: 2153
	)	
Filed: July 5, 2001	)	Examiner: Philip J. Chea
	)	
For: SUBSTITUTING URL FOR ATTACHMENT IN FORWARDING ELECTRONIC CONTENT	)	**Board of Patent Appeals and Interferences**

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed March 7, 2007, and pursuant to 37 C.F.R. § 41.37, Appellant presents this appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-11 in the Final Office Action dated December 7, 2006.

The appealed claims are set forth in the attached Claims Appendix.

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1. Real Party in Interest

This application is assigned to Koninklijke Philips Electronics N.V., the real party in interest.

2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 1-11 have been rejected in the final Office Action. The final rejection of claims 1-11 is being appealed.

4. Status of Amendments

All amendments submitted by the appellant have been entered. None were submitted after the Advisory Action.

5. Summary of Claimed Subject Matter

The present invention relates to a system and method for sending or distributing electronic content over a data network. (See Specification, p. 1, ¶ [001]). Specifically, claim 1 of the present invention describes a method of controlling communication of content information from a sender to a receiver via the data network (206). (See Id., pp. 1-2, ¶¶ [003] – [004]; pp. 2-3, ¶ [009]; and Figs. 1 and 2). The method comprises verifying (108) with a plurality of sources throughout the data network (206) whether the content information is available from at least one

of the sources (218) other than the sender (PC 202). (See Id., pp. 2-3, ¶ [009]; p. 4, ¶¶ [013] – [014]; and Figs. 1 and 2). The method further comprises contacting a search engine (216) if the content information is available from the at least one source (218), wherein the search engine (216) determines a location within the data network (206) of the at least one source (218) of the content information and returns an updateable index listing each of the sources of a copy of the content information. (See Id.). Finally, the method comprises substituting (110) for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine (216). (See Id.).

In another embodiment, claim 7 of the present invention relates to a computer readable medium storing a computer program. (See Id., p. 2, ¶ [004]; pp. 2-3, ¶ [009]; and Figs. 1 and 2). The computer readable medium comprises computer readable code for cooperation with an email application (204), the computer readable code verifying (108) with a plurality of sources throughout a world wide web whether an attachment to a specific email to be sent by a user via the world wide web is available from at least one of the sources (218) on the world wide web, contacting a search engine (216) if the attachment is available from the at least one source (218), wherein the search engine (216) determines a location within the world wide web of the at least one source (218) of the attachment and returns an updateable index listing each of the sources of a copy of the attachment, and substituting (110) for the attachment a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine (216). (See Id.).

A further embodiment, claim 8 of the present invention relates to a further computer readable medium storing a computer program. (See Id., p. 2, ¶ [005]; pp. 2-3, ¶ [009]; and Figs. 1 and 2). The computer readable medium comprises computer readable code for

cooperation with an Instant Messaging application, the computer readable code verifying (108) with a plurality of sources throughout a data network (206) whether a file to be sent by a user via the data network (206) is available from at least one of the sources (218) on the data network independent of the user (202), contacting a search engine (216) if the file is available from the at least one source (218), wherein the search engine (216) determines a location within the data network (206) of the at least one source of the file and returns an updateable index listing each of the sources of a copy of the file, and substituting (110) for the file a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine (216). (See Id.).

6. Grounds of Rejection to be Reviewed on Appeal

I. Whether claims 1-3, and 7-11 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0188841 to Jones et al. ("the Jones publication").

II. Whether claims 4-6 are unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Publication No. 2002/0188841 to Jones et al. ("the Jones publication") in view of U.S. Patent No. 6,327,656 to Zabetian ("the Zabetian patent").

7. Argument

I. The Rejection of Claims 1-3 and 7-11 Under 35 U.S.C. § 102 (e) as Being Anticipated by the Jones Publication Should Be Reversed.

A. The Examiner's Rejection

Initially, it should be noted that in the introductory sentence of the second paragraph of the Detailed Action of the 12/07/06 Final Office Action, the Examiner initially

indicated that claims 1, 2, 5-9 have been rejected under 35 U.S.C. § 102(e). (See 12/07/06 Office Action, p. 2, ¶ 2). However, within the body of the second paragraph, the Examiner's arguments are addressed to claims 1-3 and 7-11. (See Id.). Furthermore, the Examiner subsequently indicates and argues that claims 4-6 are rejected under 35 U.S.C. § 103(a). (See Id., p. 3, ¶ 4). Accordingly, Appellant will proceed with this Appeal Brief under the assumption that claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 102(e), and that claims 4-6 stand rejected under 35 U.S.C. § 103(a).

In the 12/07/06 Final Office Action, the Examiner rejected claims 1-3 and 7-11 under 35 U.S.C. § 102(e) as being anticipated by the Jones publication. (See Id., p. 2, ¶ 2). The Jones publication generally relates to systems and methods of performing digital asset management of media content. (See the Jones publication, Abstract). Specifically, the Jones publication discloses systems and processes for content searching and indexing that employ embedded watermark data in combination with other mechanisms for identifying and indexing multimedia content. (See Id., p. 3, ¶ [0035]). The processes use a combination of web searching technology with Peer-to-Peer file sharing technology. (See Id., p. 4, ¶ [0038]). As described in the Jones publication, Peer-to-Peer file sharing systems allow for "users to share files directly between their computers, with a central database or a distributed database that is passed from computer to computer." (See Id., p. 4, ¶ [0038]). Accordingly, Peer-to-Peer files sharing systems allow for content to be shared on the system, wherein one user of the system (i.e., a first peer) is the source, or ***sender***, of the content and sends the content to another user of the system (i.e., a second peer), namely the requester, or ***receiver***, of the content. The Jones publication goes on to state that the combination uses web crawlers that run locally on numerous remote networks, domains, or computers to location information on the sources. (See Id., p. 4, ¶

[0038]). In addition, watermark detectors are used to extract watermarks such as content identifiers and content type tags. (See Id.) Therefore, the web crawlers run locally on the source of the content to report back to a database, and the watermark detector determines if the content at this source contains content identifiers and/or content tags. Thus, since the content source of a Peer-to-Peer network is the content sender, the web crawlers and watermark detectors disclosed in the Jones publication are searching through *the content of the **sender** within the network.* In other words, the source of the content in the Peer-to-Peer network of the Jones publication is the ***sender*** of the content and the requester entering the search criteria is the receiver of the content. This method is decidedly separate and distinct from the method recited in claim 1 of the present invention.

B. The Cited Patents Do Not Disclose "Verifying with a Plurality of Sources Throughout the Data Network Whether the Content Information is Available From at Least One of the Sources Other than the Sender" and "Contacting a Search Engine if the Content Information is Available from the at Least One Source" as Recited in Claim 1.

According to the exemplary embodiments of the present invention, the invention purpose is to reduce bandwidth usage in viral distribution of email communication. (See Specification, p. 1, ¶ [003]). Specifically, the exemplary embodiment reviews an attachment within email from a sender to determine whether or not the attachment is a piece of content available from many sources. Accordingly, claim 1 recites a "method comprising verifying with a plurality of sources throughout the data network whether the content information is available from *at least one of the sources other than the sender...*" Claim 1 goes on to recite, "contacting a search engine *if the content information is available from the at least one source*, wherein the search engine determines a location within the data network of the at least one source of the

content information and returns an updateable index listing each of the sources of a copy of the content information."

The method recited in claim 1 refers to controlling communication of content information from a sender to a receiver via a data network. In contrast to the Jones publication, claim 1 of the present invention verifies whether the content information is available from at least one source ***other than the sender***. This is not the case in the Peer-to-Peer file-sharing network described in the Jones publication. As stated above, the web crawlers and watermark detectors of the Jones publication search for content at the sources to determine the availability of content at each source. However, the sources that are searched, according to the Jones publication, ***are*** the senders of the content. This limitation teaches away from the overall purpose of the present invention. For example, it would be possible to determine whether or not an attachment is a well-known piece of content that is available from many sources ***other than the sender of the content***. (See Specification, p. 1, ¶ 003). However, according to the Jones publication, the source of content on the Peer-to-Peer file-sharing network is the sender and the web crawlers and watermark detectors determine the availability of the content at the sender. Furthermore, the Jones publication is silent on performing a conditional step if the content is available from at least one of the sources other than the sender. Specifically, the Jones publication does teach or suggest "contacting a search engine if the content information is available from the at least one source" if it has been verified that "the content information is available from at least one of the sources other than the sender," as recited in claim 1.

In the 03/05/07 Advisory Action, the Examiner asserts that the Jones publication teaches the verification step of claim 1. (See 03/05/07 Advisory Action, p. 3, ¶ 11). Specifically, the Examiner states that the Jones publication discloses that "multiple sources

[identified by watermarks] may be searched." (See Id.). The Examiner claims that recovering content from multiple source, where one source among the multiple source can be the sender and the rest are considered at least one of the source other than the sender. (See Id.). However, simply searching multiple sources for content information does not identically show "verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender" ***and*** "contacting a search engine ***if*** the content information is available from the at least one source."

Accordingly, the method described in claim 1 includes the conditional step as to when the search engine is contacted for determine the location of another source. The Jones publication does not disclose this conditional step. This is due to the fact that the Jones publication is aimed towards accomplishing a separate purpose from the present invention, namely a Peer-to-Peer search engine. As described above, the exemplary embodiment of the present invention reviews content information from a sender to determine whether or not the content information is available from any other sources. Therefore, the availability of content information at a source other than the sender directly affects the performance of the method recited in claim 1. Specifically, the method in claim 1 will contact the search engine if another source also has the content. Otherwise, if the content information were not available from another source, the search engine would not be contacted to determine the location of another source. In contrast the method described in claim 1, the Jones publication searches multiple sources of content information, including the eventual sender of the content information. However, the availability of content information at a source other than the sender does not directly affect the performance of the method disclosed in the Jones publication. Accordingly,

the method of the Jones publication will send the content information from the sender/source regardless of the availability of the same content at a source other than the sender.

It is respectfully submitted that disclosure of the Jones publication fails to teach or suggest, a "method of controlling communication of content information from a sender to a receiver via a data network, the method comprising verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender... contacting a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of the content information..." as recited in claim 1 of the present invention. Appellant respectfully submits that for at least the reasons stated above, claim 1 of the present application is not anticipated by the Jones publication, and requests that the rejection of this claim be withdrawn. As claims 2-3 and 9 depend from, and therefore include all the limitations of claim 1, it is hereby submitted that claims 2-3 and 9 are also allowable.

The Examiner rejected claim 7 for the same reasons as the rejection of claim 1 as being anticipated by Jones. (See 12/07/06 Office Action, p. 2, ¶ 2). Claim 7 recites, "...verifying with a plurality of sources throughout a world wide web *whether an attachment to a specific email to be sent by a user via the world wide web is available from at least one of the sources on the world wide web*, contacting a search engine *if the attachment is available from the at least one source*, wherein the search engine determines a location within the world wide web of the at least one source of the attachment and returns an updateable index listing each of the sources of a copy of the attachment, and substituting for the attachment a pointer to the location of the at least one source based on the updateable index of sources returned by the search

engine." (Emphasis added). Therefore, Appellant respectfully submits that claim 7 is allowable for at least the reasons discussed above with regard to claim 1. As claim 10 depends from, and therefore includes all the limitations of claim 7, it is hereby submitted that claim 10 is also allowable.

The Examiner rejected claim 8 for the same reasons as the rejection of claim 1 as being anticipated by Jones. (See Id., p. 2, ¶ 2). Claim 8 recites, "...verifying with a plurality of sources throughout a data network *whether a file to be sent by a user via the data network is available from at least one of the sources on the data network independent of the user*, contacting a search engine *if the file is available from the at least one source*, wherein the search engine determines a location within the data network of the at least one source of the file and returns an updateable index listing each of the sources of a copy of the file, and substituting for the file a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine." (Emphasis added). Therefore, Appellant respectfully submits that claim 8 is allowable for at least the reasons discussed above with regard to claim 8. As claim 11 depends from, and therefore includes all the limitations of claim 8, it is hereby submitted that claim 11 is also allowable.

II. The Rejection of Claims 4-6 Under 35 U.S.C. § 103(a) as Being Unpatentable Over The Jones Publication and Further in View of the Zabetian Patent Should Be Reversed.

A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over the publication Jones and further in view of the Zabetian patent. (See 12/07/06 Office Action, p. 3, ¶ 4).

B. Neither the Jones Publication nor the Zabetian Patent, Alone or in Combination Discloses or Suggest "Verifying with a Plurality of Sources Throughout the Data Network Whether the Content Information is Available From at Least One of the Sources Other than the Sender," and as Recited in Claim 1.

As discussed above, the Jones publication does not teach or suggest all the limitations of independent claim 1. It is respectfully submitted that the Zabetian patent is insufficient to cure the above-stated deficiencies of the Jones publication. Because claims 4-6 depend from, and, therefore include all the limitations of claim 1, it is respectfully submitted that claims 4-6 are allowable for the reasons stated above with reference to claim 1.

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8. Conclusion

For the reasons set forth above, Appellant respectfully requests that the Board reverse the final rejections of the claims by the Examiner under 35 U.S.C. §§ 102(e) and 103(a), and indicate that claims 1-11 are allowable.

Please direct all future correspondence to:

Yan Glickberg, Esq.
IP Counsel

Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615
Email: yan.glickberg@philips.com

Respectfully submitted,

Date: May 7, 2007

By: _____
Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

CLAIMS APPENDIX

1. (Rejected) A method of controlling communication of content information from a sender to a receiver via a data network, the method comprising:

verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender;

contacting a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of the content information; and

substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

2. (Rejected) The method of claim 1, being carried out on request of at least the sender or the receiver.

3. (Rejected) The method of claim 1, wherein the verifying comprises identifying the content based on a watermark embedded in the content.

4. (Rejected) The method of claim 1, wherein the verifying comprises identifying the content based on a fingerprint of the content.

5. (Rejected) The method of claim 1, wherein the communication is conditionally being carried out depending on the sender being authorized to communicate the content information.

6. (Rejected) The method of claim 1, wherein the communication is conditionally being carried out depending on the receiver being authorized to receive the content information.

7. (Rejected) A computer readable medium storing a computer program comprising: computer readable code for cooperation with an email application, the computer readable code verifying with a plurality of sources throughout a world wide web whether an attachment to a specific

email to be sent by a user via the world wide web is available from at least one of the sources on the world wide web, contacting a search engine if the attachment is available from the at least one source, wherein the search engine determines a location within the world wide web of the at least one source of the attachment and returns an updateable index listing each of the sources of a copy of the attachment, and substituting for the attachment a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

8. (Rejected) A computer readable medium storing a computer program comprising: computer readable code for cooperation with an Instant Messaging application, the computer readable code verifying with a plurality of sources throughout a data network whether a file to be sent by a user via the data network is available from at least one of the sources on the data network independent of the user, contacting a search engine if the file is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the file and returns an updateable index listing each of the sources of a copy of the file, and substituting for the file a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

9. (Rejected) The method of claim 1, further comprising updating the updateable index of the search engine with information about the location of the at least one source of the content information.

10. (Rejected) The computer readable medium of claim 7, wherein the updateable index of the search engine is updated with information about the location of the at least one source of the attachment.

11. (Rejected) The computer readable medium of claim 8, wherein the updateable index of the search engine is updated with information about the location of the at least one source of the file.

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EVIDENCE APPENDIX

No evidence has been entered or relied upon in the present appeal.

RELATED PROCEEDING APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.